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SEP 28 2009

OFFICE OF PETITIONS

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In re Patent No. 7,478,055	: DECISION ON APPLICATION FOR
Issued: January 13, 2009	: PATENT TERM ADJUSTMENT
Application No. 09/864,525	:
Filed: May 23, 2001	:
Dkt. No.: 2842.04US01	:

This is a decision on the "PETITION UNDER 37 C.F.R. § 1.705(d)," filed March 12, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from 1338 days to 1778 days. This matter is being properly treated under 37 CFR 1.705(d) as an application for patent term adjustment.

The request for reconsideration of patent term adjustment is **DISMISSED**.

The above-identified application matured into U.S. Pat. No. 7,478,055 on January 13, 2009. The patent issued with a patent term adjustment of 1338 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 C.F.R. § 1.705(d).

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required.

Patentee requests reconsideration of the patent term adjustment and reference the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert entitlement to a patent term adjustment of 1778 days (1469 days under 37 CFR 1.702(a) + 1151 days under 37 CFR 1.702(b) – 711 overlapping days - 131 days of applicant).

Under 37 CFR 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR 1.702 reduced by the period of time equal to the period of time during which patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. In other words, patentees are entitled to the period of Office delay reduced by the period of applicant delay.

The Office asserts that as of the time of submission of the request for continued examination (RCE) on July 24, 2007, the application was pending three years and 1152 days. The Office agrees that prior to the filing of the RCE, certain action was not taken within a specified time frame, and, thus, the entry of a period of adjustment of 1381 days is correct. At issue is whether patentees should accrue an additional 1152 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 1381 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the entire 1152 day period overlaps with the 1381 day period of examination delay. Patentee's calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz.

Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

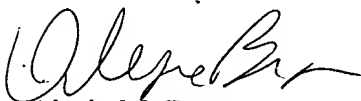
As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, May 23, 2001 to July 24, 2007, the date on which the RCE was filed. Prior to the filing of the RCE, the Office accorded 1381 of patent term adjustment for the Office failing to respond within specified time frames during the pendency of the application. All of the 1152 days for Office delay in issuing the patent overlap with the 1381 days of examination delay. The Office did not delay 1381 days and also delay an additional 1152 days.

The 1152 days attributed to the delay in the issuance of the patent overlaps with the adjustment of 1381 days attributable to the grounds specified in 37 C.F.R. § 1.702(a)(1). Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment for the Office taking in excess of 3 years to issue the patent.

In view thereof, no adjustment to the patent term of 1338 days (1469 days less 131 days) will be made.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.



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